Supreme Court, U.S.
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No. ____ OFFICE OF THE CLERK

IN THE SUPREME COURT OF THE UNITED STATES

October Term, 1997

SASHCO, INC.

Petitioner,

vs.

DAP PRODUCTS, INC.

Respondent.

On Petition for Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Where a district court improperly construes claims of a validly issued United States patent, may the Court of Appeals for the Federal Circuit affirm such finding under a de novo review standard without issuing an opinion, the result of which deprives the patent owner of valuable property rights?

2. Should this Court exercise its supervisory power to correct improper claim constructions of validly issued United States patents when the method of construction significantly departs from established judicial proceedings and by doing so eliminates protection granted by the United States Patent Office?

PARTIES TO THE PROCEEDING

Sashco, Inc., Petitioner, is a Colorado corporation. Sashco, Inc., has no parent company and has no nonwholly owned subsidiaries.

Respondent is DAP Products, Inc., as named on the cover of this petition.

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OPINIONS BELOW

The Notice of Entry of Judgment Without Opinion and the Judgment of the United States Court of Appeals for the Federal Circuit is reported at 113 F.3d 1255 (Fed. Cir. 1997), and is reprinted at B-1 through B-4 of the Appendix hereto. The order of the United States Court of Appeals for the Federal Circuit on petition for rehearing is reprinted at page C-1 through C-2 of the Appendix hereto. The unpublished Decision and Judgment of the United States District Court for the Southern District of Ohio (Western Division) is reported at 106 F.3d 427 (S.D. Ohio 1996), and is reprinted at A-1 through A-52 of the Appendix hereto.

JURISDICTION

The United States Court of Appeals for the Federal Circuit entered judgment on April 14, 1997. Sashco, Inc. timely filed a combined petition for rehearing and suggestion for rehearing in banc on April 28, 1997. The Order denying the petition for rehearing and declining the suggestion for rehearing in banc was entered on June 11, 1997. Petitioner invokes the jurisdiction of this Court pursuant to 28 U.S.C. § 1254(1).

STATEMENT OF THE CASE

Petitioner, Sashco, Inc. ("Sashco"), is a manufacturer of various products widely used in the construction industry. Among these products include sealants and caulks used for both commercial and residential construction, as well as repair. Sealants are similar to caulks but

exhibit enhanced adhesion characteristics.

In the earlier 1980's, two principals of Sashco conceived of a unique product for the construction industry. This unique product is a substantially transparent sealant packaged in a cartridge having a transparent sidewall. The cartridge has a dispensing nozzle at a downstream end and a piston at an upstream end and thus fits a standard caulking gun.

In use, a ram that is driven by the caulking gun advances the cartridge's piston, which in turn dispenses the caulk out of the nozzle and onto a substrate as an extruded bead. Sashco's innovative packaging enables a user to see all the way through the combination of the transparent cartridge and the transparent caulking material.

In August 1986, the inventors filed a patent application that was assigned to Sashco. This application matured to issue as U.S. Patent No. 4,776,458 (the " '458 Patent"). The '458 Patent broadly claims the combination of a clear caulking material contained in a cartridge having a transparent sidewall. The '458 Patent includes eight claims, only one of which is independent. A copy of the '458 Patent appears at pages D-1 through D-6 of the Patent Documents Appendix. While the preferred embodiment disclosed in the '458 Patent is a cylindrical cartridge product, the specification explicitly states that tubular cartridges of other geometric cross-sections are included in the invention. D-4, Column 4, lines 9-13.

During the pendency of the application for the '458 Patent, Sashco filed a second

patent application directed to a substantially transparent caulking compound packaged in a clear squeeze-tube. The second application was a continuation-in-part of the earlier application, and this second application matured to issue as U.S. Patent No. 4,863,014 (the " '014 Patent"). A copy of the '014 Patent appears at pages E-1 through E-8 of the Patent Documents Appendix. The preferred embodiment disclosed in the '014 Patent is a cylindrical tube that is collapsed at one end. Such construction results in a "toothpaste-type" squeeze tube.

Beginning in 1986, Sashco produced and marketed a clear sealant in a substantially transparent cartridge according to the teachings of what later became the '458 Patent. Sashco identified this sealant product by the trademark Lexel® (the "Lexel® Cartridge Product"). In 1988, Sashco also began selling the sealant in a clear "toothpaste-type" squeeze tube, also under the Lexel® brandname (the "Lexel® Squeeze Tube Product"). Sashco's Lexel® brand products received six (6) industry awards for innovation and packaging. The successful impact of the Lexel® brand products in the marketplace has resulted in competitive copying of Sashco's packaging.

Respondent, DAP Products, Inc. ("DAP"), is one of Sashco's competitors. From September 20, 1991 until sometime in 1993, DAP sold two products intended to compete with Sashco's patented packaging. DAP placed its clear caulk in a clear cylindrical cartridge but masked slightly more than one-half of the circumference (58%) of the cartridge with translucent material (the "DAP Clear Cartridge Product"). In another of these products,

referred to as the DAP Clear Squeeze Tube Product, DAP placed its clear caulk in a clear toothpaste-type squeeze tube.

The proceeding in the district court was commenced by DAP as a declaratory judgment action seeking to have the '458 Patent and the '014 Patent declared invalid and unenforceable. DAP also requested a declaration that the DAP Clear Cartridge Product did not infringe Sashco's '458 Patent and that the DAP Clear Squeeze Tube Product did not infringe Sashco's '014 Patent. Federal jurisdiction over patent questions in the original proceeding was premised on 28 U.S.C. §1338(a) and 28 U.S.C. §2201. Sashco counterclaimed for infringement of each of these patents, also premising federal jurisdiction on 28 U.S.C. §1338(a).

Both parties filed motions for partial summary judgment on the infringement issues. Sashco additionally sought summary adjudication on an issue related to Lanham Act claims, and DAP sought a summary ruling on invalidity of the two patents. The summary judgment issues were presented by affidavit, and oral argument was held before the district court on March 1, 1996.

On July 17, 1996 the district court filed a written opinion on these issues and judgment was entered on July 25, 1996. This decision is found in the Appendix at App. A-1 through A-52. The district court: (1) entered summary judgment in favor of DAP on the issues of infringement of Sashco's patents; (2) found the existence of material facts on the issues of validity and enforceability of Sashco's patents and, therefore, denied DAP's motion on these claims; and (3) concluded that the

remaining issues were moot.

Integral to its decision, the district court construed independent claim 1 of each of the '458 Patent and the '014 Patent under the authority of Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed. Cir. 1995), aff'd, 116 S.Ct. 1384 (1996). The district court arrived at each of these claim constructions by sua sponte resorting to definitions in dictionaries that were neither in the record nor argued by the litigants.

In order to find non-infringement of the '458 Patent, the district court held independent claim 1 to be limited to cylindrical cartridges, and then, only to situations where "a user must see through the central longitudinal axis of the cartridge in order to view the opposite point (rather than side) of the cartridge, exactly one hundred and eighty degrees on the circle from the initial point." (emphasis in original) App. A-26.

With respect to its finding of non-infringement of the '014 Patent, the district court held that independent claim 1 did not cover the toothpaste-type tube disclosed in the specification. Rather, the district court interpreted the words of the claim to be limited to some other container construction. See, App. A-36 - A-37.

In the case of the '458 Patent, the district court analyzed selected definitions of the words "tube", "cylinder", "circle", "side", "line", "polygon", "rectangle", "square", "transverse, "across" and "axis". Even though many of these words do not even

appear in claim 1 or the specification of the '458 Patent, the district court ultimately concluded that claim 1 was limited to cylindrical containers only where a user could view through the center the container. App. A-26 - A-27.

With respect to claim 1 of the '014 Patent, the district court focused on a dictionary definition of the word "flattened" to require that a container would have to have a changing slope from one end to the other. Since the district court thought that a toothpaste-type tube changes dimension, but not its degree of slope, the collapsed region opposite the nozzle did not qualify as "flattened" despite the specification's illustration and explanation of the manufacture of the invention to be this specific construction.

Sashco appealed the district court's claim constructions both as to result and as to the methodology employed, and oral argument was held before a three member panel of the United States Court of Appeals for the Federal Circuit ("CAFC") on April 8, 1997. The CAFC entered judgment on April 14, 1997, affirming the district court's ruling. This judgment was entered without opinion pursuant to Fed. Cir. R. 36, giving no indication of the specific provision of Rule 36 relied upon.

Sashco filed a combined petition for rehearing and suggestion for rehearing in banc, and the CAFC requested that DAP respond to this petition. The CAFC subsequently issued its decision denying the rehearing on June 11, 1997, and a mandate to this effect was entered on June 18, 1997.

REASONS FOR GRANTING THE PETITION

This petition raises serious questions directed to the role of an appellate court, namely, the United States Court of Appeals for the Federal Circuit, in reviewing a federal district court's claim construction of a validly issued letters patent. Petitioner seeks to have this Court exercise its supervisory power to rectify a situation where a United States Court of Appeals has sanctioned a decision by a lower court that so departs from the accepted and usual course of judicial proceedings, as to call for an exercise of that supervisory power. Sup. Ct. R. 10(a).

A patent is a valuable property right conferred by Congress under the authority of Article I, §8, cl. 8 of the Constitution. The extent of that grant is laden with public interest in addition to the interest of the patent holder. A patent grants the holder the right to exclude others from making, using, offering for sale, selling, or importing the patented invention. H. Schwartz, Patent Law and Practice 1, 33 (2d ed. 1995).

Importantly, a patent uses words in describing the exact scope of an invention to "secure to [the patentee] all to which he is entitled, [and] to apprise the public of what is still open to them." McClain v. Ortmayer, 141 U.S. 419, 424 (1891). A patent, therefore, includes one or more "claims" which "particularly point out and distinctly claim the subject matter which the applicant regards as his invention." 35 U.S.C. §112. Improper claim construction leads to a distorted infringement analysis. Key Manufacturing Group, Inc. v. Microdot, Inc., 925 F.2d

1444, 17 USPQ2d 1806 (Fed. Cir. 1991).

Recently, this Court resolved the issue of whether the construction of a patent's claims is exclusively with the province of the court or is subject to a Seventh Amendment guarantee that a jury is to determine the meaning of any disputed term of art. Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed. Cir. 1995), aff'd, 116 S.Ct. 1384 (1996). In a unanimous opinion, this Court held that the construction of a patent, including terms of art within its claims, is exclusively with the province of the court. Id.

I. THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT IS TO REVIEW PATENT CLAIM CONSTRUCTION DE NOVO

The United States Court of Appeals for the Federal Circuit (CAFC) was created October 1, 1982 for the purpose of achieving uniformity in the exposition and application of substantive patent law. E.g., Atari, Inc. v. JS&A Grove, Inc., 747 F.2d 1422 (Fed. Cir. 1984); Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564 (Fed. Cir. 1984). Congress conferred on the CAFC exclusive appellate jurisdiction in patent cases, and one of the court's goals is to increase doctrinal stability in the field of patent law. Chemical Eng'g Corp. v. Marlo, Inc., 754 F.2d 331 (Fed. Cir. 1984).

The CAFC employs different standards of review depending upon the nature of the issue before it and whether the matter was tried to the court or to a jury. With respect to factual findings, a jury's resolution is reviewed under the restrictive standard of "substantial

evidence". Jurgens v. McKasy, 927 F.2d 1552, 18 USPQ2d 1031 (Fed. Cir. 1991). A district judge's factual findings are reviewed under a clearly erroneous standard. Rite-Hite Corp. v. Kelley Company, Inc., 819 F.2d 1120, 2 USPQ2d 1915 (Fed. Cir. 1987). Equitable issues, for example, laches, estoppel and inequitable conduct, are reviewed for an abuse of discretion. See Jamesbury Corp. v. Litton Industrial Products, Inc., 839 F.2d 1544, 5 USPQ2d 1779 (Fed. Cir. 1988). In all cases, however, questions of law are to be reviewed de novo. See Jurgens v. McKasy, supra; Ferag AG v. Quipp Inc., 45 F.3d 1562, 33 USPQ2d 1512 (Fed. Cir. 1995).

Importantly, there is no question that the CAFC is under its own articulated duty to review a district court's claim construction under a de novo review standard, like any other legal question. Markman, supra. The CAFC characterizes questions for de novo consideration as both "subject to full and independent review by this court. ...", Newell Companies, Inc. v. Kenney Manufacturing Co., 864 F.2d 757, 9 USPQ2d 1417 (Fed. Cir. 1988) and subject to "a complete and independent analysis of [the issue of law]." Hoganas AB v. Dresser Industries, Inc., 18 F.3d 927, 30 USPQ2d 1070 (Fed. Cir. 1993).

The general question then becomes what, if any, duty is on an appellate court to explain the basis of its de novo review. The specific question for patent cases is whether the CAFC should be required to articulate some rationale for its "complete and independent analysis" of claim construction.

The question where applied to patent cases takes added significance because there is but a single path of appellate review. Previously, patent claim construction could readily be reviewed by this Court where different circuit courts of appeal construed a patent's claims differently. See, Keller v. Adams Campbell Co., 264 U.S. 314 (1924). That possibility no longer exists. Thus, a special need exists to have written explanation when the public and private rights are affected, such as the case of patent claim construction.

II. FEDERAL APPELLATE RULE 36 SHOULD NOT ENCOMPASS LEGAL ISSUES OF PATENT CLAIM CONSTRUCTION

Appellate courts are implicitly authorized to enter judgments without an opinion. Fed. R. App. P., Rule 36.[1]

Various circuit courts have established their own bases for implementation of Rule 36. In the case of the CAFC, the language is:

> Rule 36. Entry of Judgment
>
> Judgment of affirmance without opinion.-The court may enter a

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[1] In 1975, the Commission on Revision of the Federal Rules recommended that in all cases there should be "some record, however brief, and whatever form, of the reasoning which compelled the decision." See, Commission on Revision of the Federal Appellate System, Structure and Internal Procedures: Recommendations for Change 50 (Final Report)(1975).

judgment of affirmance without opinion, citing this rule, when it determines that any of the following circumstances exist:

(a) the judgment, decision or order of the trial court appealed from is based on findings that are not clearly erroneous;

(b) the evidence in support of a jury verdict is sufficient;

(c) summary judgment, directed verdict, or judgment on the pleadings is supported by the record;

(d) the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review; or

(e) a judgment or decision has been entered without an error of law; and an opinion would have no precedential value.

Fed. Cir. R. 36

Where a district court construes the claims of a patent pursuant to Markman, supra, Fed. Cir. R. 36 (b) and (d) do not pertain. Thus, the CAFC proceeds under the alternative subsections if it enters a judgment without opinion on patent claim construction. However, since Rule 36 allows entry of a judgment of affirmance without opinion if only one of subsections (a), (c) or (e) is satisfied, a peculiar result is obtained where the issue is

patent claim construction.

It may be that the CAFC ratifies the claim construction because there is "support in the record" for the claim construction and the judge correctly applied the law despite clearly erroneous factual findings. This approach seems to contradict the de novo standard, replacing that liberal standard with the most restrictive "substantial evidence" standard of review of jury findings of fact.

Alternatively, it may be that the CAFC chooses not to issue an opinion even where there has been an absolute error of law, but hinges its lack of opinion on the premise that there is no clearly erroneous factual finding. As suggested infra at pp. 25-27, Petitioner requests this Court to exercise its supervisory powers because the CAFC has, in this particular appeal, sanctioned a far departure from law. There has been no explanation for such sanctioning where the judgment enters pursuant to Rule 36. Moreover, the CAFC has less ability to determine if an in banc hearing is warranted where there is no explanation of the rationale for the affirmance.

While Petitioner is mindful that Rule 36 is helpful for judicial economy, this Court has already exercised its power of review by writ of certiorari in a summary disposal of an action. Taylor v. McKeithen, 407 U.S. 191, 92 S.Ct. 1980 (1972). In Taylor, this Court granted the petition, vacated the judgment below and remanded the case "[b]ecause the record does not fully inform us of the precise nature of the litigation and because we have not had the benefit of the insight of

the Court of Appeals." 407 U.S. at 1994, 92 S.Ct. at 1982.

In light of the errors of law existing at the federal court level, the insight of the appellate court is necessary to explain the taking of Petitioner's patent rights.

III. THE APPELLATE COURT SANCTIONED A LEGAL APPROACH TO CLAIM CONSTRUCTION THAT DEPARTED FROM ACCEPTED JUDICIAL PROCEEDING

The path travelled by the district court in construing the claims of the '458 Patent and the '014 Patent expressly contravened numerous rules of analysis established over the years by both this Court and the CAFC. In its approach, the district court relied first and foremost on extrinsic evidence before even considering the intrinsic evidence present in the specifications and the prosecution histories of the respective patents. This methodology was a clear error of law leading to an incorrect claim interpretation for each patent involved.

By affirming without opinion such a significant departure from established guidelines, the CAFC implicitly sanctions the district court's analytical technique. This impacts not only the litigants in this case but also the law of claim construction to be applied in the future. This is, therefore, a serious issue which merits the immediate attention of this Court.

The art of properly construing patent claims has long captured the attention of this Court and, over time, various canons of interpretation have been established to preserve uniformity. Fundamentally,

"[p]atents for inventions are to receive a liberal construction, to uphold, and not to destroy, the right of the inventor." Winans v. Denmead, 14 L.Ed. 717, 722 (1853). It is not the role of courts "to enlarge or restrict the scope of patents which by mistake were issued in terms too narrow or too broad to cover the invention, however manifest the fact and extent of the mistake may be shown to have been." United States Repair & Guaranty Co. v. Assyrian Asphalt Co., 183 U.S. 591, 601, 22 S. Ct. 87, 91 (1901). Rather, "it is the province of the court to determine what the subject-matter is upon the whole face of the specification and the accompanying drawings." Bates v. Coe, 98 U.S. 31, 38-39 (1878). "The true role of construction in respect to patents and specifications is to apply to them plain and ordinary principles and not to yield to subtleties and technicalities." Hogg v. Emerson, 12 L.Ed. 505, 525 (1848).

More recently, in Markman, supra, the CAFC discussed at length the role of the judge and jury in construing a patent's claims. In doing so, the court examined and summarized many of the rules of law on claim construction. For example, the CAFC observed that "[t]he patent is a fully integrated written instrument." Markman, supra, 52 F.3d at 978. Accordingly, "a patent is uniquely suited for having its meaning and scope determined entirely by a court as a matter of law." Id. (citations omitted).

The integrated instrument includes the claims and the specification. "First, we look to the words of the claims themselves, both asserted and unasserted, to define the scope of the patented invention." Vitronics

Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996) (citation omitted). Words are to be given "their ordinary and customary meaning" unless the patentee has used any terms "in a manner other than their ordinary meaning." Id. "Thus, second, it is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning." Id.

Even though the "specification acts as a dictionary" and "is always highly relevant to the claim construction analysis", Vitronics, supra, 90 F.3d at 1582, it is only a tool of claim construction and is not to be used to read limitations into the claims. Intervet America, Inc. v. Kee-Vet Laboratories, Inc., 887 F.2d 1050, 12 USPQ2d 1474 (Fed. Cir. 1989).

Third, "the court should also consider the patent's prosecution history, if it is in evidence." Markman, supra, 52 F.3d at 980 (citing Graham v. John Deere Co., 383 U.S.1, 33, 86 S.Ct. 684, 701, 15 L.Ed.2d 545, 148 USPQ 459, 473, (1966))(emphasis added). Here, the prosecution history is only employed in understanding the language used in the claims and cannot be used to enlarge, diminish or vary the limitations in the claims. Id.

As noted in the Vitronics case:

> In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such circumstances, it

> is improper to rely on extrinsic evidence . . . In those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper. . . . Allowing the public record to be altered or changed by extrinsic evidence introduced at trial . . . . would make this right meaningless. Vitronics, supra, 90 F.3d at 1583.

Clearly, District Court "may, in its discretion, receive extrinsic evidence in order 'to aid the court in coming to a correct conclusion' as to the 'true meaning of the language employed' in the patent." Markman, supra, 52 F.3d at 980 (citing Seymour v. Osbourne, 78 U.S. (11 Wall.) 516, 546, 20 L.Ed.33 (1871)). Importantly, however, the Markman court was unequivocal that "[e]xtrinsic evidence is to be used for the court's understanding of the patent, not for the purpose of varying or contradicting the terms of the claims." Markman, supra, 52 F.3d at 981. The CAFC subsequently approved the narrow use of extrinsic evidence in Vitronics, supra, 90 F.2d 1576 (Fed. Cir. 1996) and Hoechst Celanese Corp. v. BP Chemicals, Ltd., 78 F.3d 1575 (Fed. Cir. 1996).

Despite these established guidelines, the district court in this case adopted an antithetical approach in construing the claims of Sashco's patents. The result was neither the language of the claims as issued, nor as construed under the intrinsic evidence. Only after reaching such construction with extrinsic evidence did the district court even consider the

intrinsic evidence to see if there was any support for it. This approach departs radically to such a degree that this Court should intervene and exercise its supervisory powers.

In construing claim 1 of the '458 Patent, the district court initially focused on the purported limitation of a cylindrical cartridge. The district court found this limitation problematic, which is not surprising because neither the word "cylindrical", nor any variation thereof, can be found in claim 1. Nonetheless, the district court labored to interpret certain language from claim 1, stating:

> "Before turning to extrinsic evidence and the prosecution history of this patent, this Court must first address a problematic aspect of the above-quoted language. This claim describes a cylindrical cartridge that is substantially transparent in the transverse direction so that a user may see from one 'side' of the cartridge to the other." App. A-23 - A-24. (emphasis added)

To incorporate the limitation of a cylindrical cartridge, the district court noted the recitation of a "tubular housing" in claim 1 and read the definition of "tube" from Webster's Third New International Dictionary to be "a hollow, elongated, usually cylindrical body." App. A-24, n.8. From this, the district court construed the claim to cover only a cylindrical tubular body. The specification of the '458 Patent states unequivocally to the contrary:

> In FIG. 1, the preferred embodiment of the present invention is shown as a caulking tube or container 10 in the form of an elongated tubular housing 12 which is preferably cylindrical in shape, but which could take a variety of cross-sectional geometric shapes, if desired. D-4, column 4, lines 9-13 (emphasis provided).

Having launched its analysis in the wrong direction by relying on extrinsic evidence not of record, the district court next eliminated claim 1's requirement that a user be able to see completely through "from one side of the cartridge to the other." D-6, column 7, lines 41-46. The district court did so by stating that, since it had determined the cartridge was cylindrical, it would "think about this description in terms of circles." App. A-24. Again using dictionaries, the district court observed that "a circle has no 'sides'." Id. Thus, this important language in claim 1 is "less helpful than might initially be supposed." App. A-25.

The district court chose to "focus instead upon the meaning of the phrase 'substantially transparent in the transverse direction.'" Id. Now, again disregarding the established rules of claim construction, the district court went on to state:

> - Relying upon its authority to look to extrinsic evidence for assistance in construing the meaning of this claim, this Court will turn first to the

dictionary. The definition of "transverse" is "extended or lying across or in a crosswise direction." Webster's Third New International Dictionary, 2431 (unabridged 1976). The term "across" is defined as "to or on the opposite side." Id. at 20. Although this might appear merely to bring this Court to its earlier observation that a cylindrical cartridge does not have sides, the term "opposite" is a useful addition, suggesting that a user must see through the central longitudinal axis of the cartridge in order to view the opposite point (rather than side) of the cartridge, exactly one hundred and eighty degrees on the circle from the initial point. App. A-26. (emphasis added)

Having sua sponte resorted to various dictionaries for the definitions of several words, the majority of which do not even appear in claim 1 of the '458 Patent, the district court ultimately concluded:

> "For the foregoing reasons, this Court will interpret the phrase 'in the transverse direction' to mean toward the opposite point of the [cylindrical] cartridge (i.e. one-hundred and eighty degrees from the initial point), and toward all points which are directly above and below that point. This construction necessarily limits the patent to situations wherein the user may

> view directly through the central longitudinal axis of the cartridge." App. A-29. (emphasis provided)

Such a conclusion, however, contradicts the claim and the prosecution history, as entered into evidence, which refer to a user and his ability to see. In this context it is entirely proper to refer to sides of cylinders or other cross-sectional shapes, such as "front side", "back side", "left side", "right side", etc., as is shown by the district court's own usage:

> [7] For example, Defendant attached pictures to its Motion for Partial Summary Judgment which showed that one can view through the Plaintiff's product and see a colored line which is taped to the wall behind the cartridge (Doc. #61, Exh. J). On cannot, however, view the colored line through the <u>center</u> of the cartridge; instead, <u>the line can only be seen through less than half of the right side of the cartridge</u>. App. A-23, n.7. (emphasis partially added)

Claim 1's language "from one side of the cartridge to the other" was important language requested by the Examiner to eliminate situations where one could see into but not completely through the cartridge. Thus, error of law was committed by effectively <u>deleting</u> language important for allowance of the claim and its construction and then construing the resulting language by extrinsic evidence <u>first</u>, before considering what the

"across" on which the district court solely relied to narrow the claim is not even found in the text of that claim.

In the case of the '014 Patent, the district court's resort first to extrinsic evidence led to a more bizarre result. The methodology for its claim construction was articulated precisely: "As before, this Court will use the dictionary as a starting point for its analysis . . ." App. A-36. (emphasis added)

Instead of looking first to the claim language and, if necessary, to intrinsic evidence, the district court focused instead "on the requirement that the caulking compound in the specified region have 'a substantially uniform, flattened configuration.'" Id. (emphasis in original). It then turned to the dictionary to determine that:

> "[t]he term 'flat' is defined as 'having or marked by a continuous surface that is horizontal or nearly so without significant curvature or inclination.' App. A-26.

The term 'flattened' means 'reduced to an even or more nearly even surface'. . .. Therefore, a straightforward interpretation of this claim requires the slope or inclination of the tube to be noticeably reduced in [the region of reduced thickness], so that the surface of the tube (and the compound within it) becomes more horizontal and even." App. A-36 - A-37.

The district court then ruled that this construction specifically removed from claim 1 any container shaped as a toothpaste tube, stating: "Accordingly, a toothpaste tube which does not have an appreciably 'flattened' region, but which merely has an unchanging, tapered slope from one end of the tube to the other, will not fall within this patent's definition." App. A-37.

Apparently, the slope that the district court considered was longitudinal slope. Thus, the district court interpreted claim 1 of the '014 Patent to require longitudinal sidewalls that change in slope from a greater slope near the nozzle to a negligible slope as the sidewalls approach the upstream end. Here again, the district court's starting point in arriving at such a claim construction was to extrinsic definitions from a dictionary not of record in the proceeding. The district court bolstered this flawed interpretation by referencing language of the '014 Patent discussing Figure 5, wherein the squeeze tube has been creased in an unnatural state to create a packet as specifically explained in the patent text. See E-7, Column 5, lines 48-66.

But the only embodiment of the container disclosed in the specification of the '014 Patent is a uniformly tapering toothpaste tube. The specification describes, using the language of claim 1, exactly how the container according to the invention is to be formed. See E-7, column 5, lines 48-66.

Claim 1 covers the toothpaste tube preferred embodiment as well as other containers that have the recited features.

Nonetheless, the '014 Patent specifically claims the toothpaste tube container in dependent claims 8 and 9 as a more limited structure than the broader recitations of claim 1.

Claim 8 recites:

> 8. A product according to claim 1 wherein said second closure is formed by collapsing a second end portion of said sidewall against itself along a linear region transverse to said longitudinal axis and sealing said sidewall second end portion together to form a scaled margin at the upstream end of the container. See, E-8, column 7, lines 33-38.

Claim 9 recites:

> 9. A product according to claim 8 wherein said sidewall is a tubular member such that said upstream end is circular in cross section. See, E-8, column 7, lines 39-41.

Thus, perhaps for first time ever has a district court removed a claim (i.e. claim 9) from a patent by claim construction of its parent claim. This is indeed a serious and material issue of law. Petitioner suggests the law demands correction of this error, not only to preserve the patent rights it received from the United States, but to curtail any apparent endorsement of this practice in the future.

Moreover, a claim interpretation that excludes the inventor's device is rarely the correct interpretation, Modine Mfg. Co. v. United States Int'l Trade Comm'n, 75 F.3d 1545, 37 USPQ2d 1609 (Fed. Cir. 1996), and "it is unlikely that an inventor would define the invention in a way that excluded the preferred embodiment . . .". Hoechst, supra, 78 F.3d 1575 at 1581.

Thus, the District Court committed error, and the CAFC sanctioned this error by affirming without opinion. Had the CAFC considered claim 1 of the '014 Patent to be properly construed by the district court, its affirmance on de novo review should have been articulated with reasoning in comport with Markman, supra, and Vitronics, supra. It was not Petitioner's burden of proof to demonstrate that the claims mean anything other than what the integrated patent document teaches. Indeed, there has never been an amendment nor anything of record to modify or reinterpret the language of claim 1 as originally presented and allowed.

The language through which a patent's claims are expressed "is not a nose of wax to be pushed and shoved into a form that pleases and that produces a particular result a court may desire." Exxon Chemical Patents, Inc. v. Lubrizol Corp., 64 F.3d 1553, 1563 (Fed. Cir. 1995) (Judge Plager concurring). "Courts can neither broaden nor narrow claims to give the patentee something different than what he has set forth." Autogiro Co. of Am. v. United States, 384 F.2d 391, 396, 181 Ct.Cl.55, 155 USPQ 697, 701 (1967).

By ascribing to the district court's approach in construing the claims solely by

extrinsic evidence, the CAFC undercuts Markman and brings to question the entire body of law on claim construction. The result is a return to uncertainty where the claims are not interpreted by the public record, but rather by which dictionary or other extrinsic evidence is selected and, with respect to dictionary definitions, which among the many possible meanings for a specific word that the particular trial judge prefers, even when that extrinsic evidence is not placed in the record by the parties.

In this case it was improper as a matter of law to look at extrinsic evidence at all, let alone as the first and primary means of claim construction. The affirmance of this approach is a step backwards to less certainty, for to do so allows claims to again be treated as a "nose of wax". This is detrimental to patent holders, accused infringers and the public as a whole.

In view of the district court's serious departure in claim construction, and the sanctioning of such an approach "by the three-judge CAFC panel", this case presents an issue of pressing importance which is deservant of immediate attention to prevent future misapplications of the law of claim construction. Petitioner, therefore, asks this Court to invoke its discretionary powers under Sup. Ct. R. 10(a) to curtail the further sanctioning by the CAFC of such an approach.

IV. WHERE THE CASE CONCERNS MATTERS OF FEDERAL LAW, THE SUPREME COURT EXERCISES ITS SUPERVISORY AUTHORITY

Patent law is a federal matter. Congress has seen fit in discharging its Constitutional authorization to grant exclusive jurisdiction over patent cases to the federal courts. 28 U.S.C. §1338(a). Federal law preempts any state laws to the contrary.

Whereas this Court's intervention in certain state court matters may be more proscribed, the establishment and maintenance of standards in federal matters are not so restricted. McNabb v. U.S., 318 U.S. 332 (1943). In McNabb, this Court exercised its general judicial supervisory powers over federal criminal law to grant certiorari and reverse the appellate court's affirmance of certain criminal convictions. This power is expressly distinct from Constitutional issues. Where lower courts depart from the procedure normally followed in addressing statutory and constitutional questions, especially in important matters, this Court exercises its supervisory powers. New York Transit Authority v. Beazer, 440 U.S. 568 (1979).

This Court has also granted certiorari in a patent case, exercising its supervisory power, where a "conflict of decisions [in other circuits], is unlikely." Muncie Gear Co. v. Outboard Co., 315 U.S. 759 (1942) (Citing, Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47). The creation of the CAFC in 1992, means that there is no longer a likelihood that there will be a conflict of decisions on claim interpretation. While this is a positive step for uniformity, the

role of this Court in supervising the CAFC on patent matters necessarily increases.

Once a patent issues, it is presumed valid. 35 U.S.C. §282, and "[e]ach claim of a patent . . . shall be presumed valid independently of the validity of other claims . . . ." Id. One charged with infringement can raise as a defense any failure to comply with Title 35. However, such defense must be proven with clear and convincing evidence. The primary defenses raised in attempts to invalidate patent claims are lack of novelty (35 U.S.C. §102), obviousness (35 U.S.C. §103) or some technical defect, such as vagueness or ambiguity (35 U.S.C. §112).

None of these defenses is relevant to the construction of the scope of the claims in the '458 Patent or the '014 Patent. However, the district court, by failing to apply the claims as written and in the context of the specification, as historical federal precedent demands, used his ability to construe the claims to eliminate protection clearly afforded the patent holder by the United States Patent Office.

In the '458 patent, the district court eliminated all geometrical constructs of the tubular housing, except cylindrical, which in turn led to other erroneous limitations. In the '014 Patent, the district court in effect canceled validly issued claims (claims 8 and 9) without any statutory basis under Title 35 even though such claims are presumed to have independent validity.

There is substantial need for this Court to require that lower courts follow established precedent and use the

procedures normally followed in statutory questions. The only way to ensure compliance in such a strictly federal matter as patent law is for this Court to exercise its supervisory powers under Sup. Ct. R. 10(a).

CONCLUSION

Patent rights owned by petitioner, Sashco, Inc., have been lost solely by a district court's claim construction that departs not only from the claimed language, the respective specifications of the two patents and the prosecution history, but also from an implementation by the district court of a judicial procedure contrary to established precedent. These departures were affirmed without opinion. Sashco requests this Court exercise its supervisory authority to review this matter and, upon full briefing and the record, to correct those errors of claim construction.

Respectfully submitted this 9th day of September 1997.

Timothy J. Martin
Attorney for Petitioner

APPENDIX A

IN THE UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF OHIO
WESTERN DIVISION AT DAYTON

DAP PRODUCTS, INC.,

Plaintiff(s)

vs

Case No.: C-3-92-407

SASHCO, INC.,

Defendant(s)

JUDGMENT IN A CIVIL CASE

Jury Verdict. This action came before the Court for a trial by jury. The issues have been tried and the jury has rendered its verdict.

X **Decision by Court.** This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

IT IS ORDERED AND ADJUDGED that a declaratory judgment of non-infringement is entered for Plaintiff as to both patents at issue in this litigation, pursuant to Rule 54(b) or the Federal Rules of Civil Procedure, and that judgment is entered in favor of Plaintiff and against Defendant on Defendant's counterclaims, pursuant to Rule 54(b) of the Federal Rules of Civil Procedure, the court having concluded, with regard to both branches of this judgment entry, for reasons set forth in its

Decision of July 17, 1996 (Doc. #87), that there exists no just reason for delay.

July 25, 1996
Date

Kenneth J. Murphy, Clerk

s/_____
(By) Deputy Clerk

IN THE UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF OHIO
WESTERN DIVISION AT DAYTON

DAP PRODUCTS, INC.,	:	
Plaintiff(s)	:	
vs	:	Case No.: C-3-92-407
SASHCO, INC.,	:	
Defendant(s)	:	JUDGE WALTER HERBERT RICE

DECISION AND ENTRY OVERRULING DEFENDANT'S MOTION FOR PARTIAL SUMMARY JUDGMENT (DOC. #61) AS TO ITS COUNTERCLAIMS AND COUNT THREE OF PLAINTIFF'S COMPLAINT; DECISION AND ENTRY OVERRULING AS MOOT DEFENDANT'S MOTION FOR PARTIAL SUMMARY JUDGMENT REGARDING PLAINTIFF'S FIRST AND SECOND COUNTS, WITHOUT PREJUDICE TO RENEWAL IF CLAIMS ARE DEEMED VIABLE; DECISION AND ENTRY SUSTAINING, NUNC PRO TUNC MARCH 1, 1996, PLAINTIFF'S MOTION FOR A HEARING ON THE AFORESAID MOTION (DOC. #62); DECISION AND ENTRY SUSTAINING IN PART AND OVERRULING IN PART PLAINTIFF'S MOTION FOR PARTIAL SUMMARY JUDGMENT (DOC. #64); DECISION AND ENTRY OVERRULING AS MOOT PLAINTIFF'S MOTION TO COMPEL DEFENDANT'S EXPERT WITNESS TO ANSWER CERTAIN DEPOSITION QUESTIONS (DOC. #66); DECISION AND ENTRY OVERRULING AS MOOT PLAINTIFF'S MOTION TO STRIKE DEFENDANT'S EXPERT WITNESS (DOC. #66); DECISION AND ENTRY OVERRULING AS MOOT DEFENDANT'S MOTION FOR A PROTECTIVE ORDER (DOC. #72); DECISION AND ENTRY OVERRULING AS MOOT PLAINTIFF'S MOTION TO EXCLUDE EVIDENCE OF DEFENDANT'S NEW DAMAGE THEORIES (DOC. #74); DECISION

AND ENTRY OVERRULING AS MOOT DEFENDANT'S MOTION TO COMPEL PLAINTIFF TO ANSWER INTERROGATORIES (DOC. #78); PARTIES DIRECTED TO INFORM THIS COURT, WITHIN THREE (3) DAYS OF THE DATE OF THIS DECISION, OF THE STATUS OF COUNTS ONE AND TWO OF PLAINTIFF'S COMPLAINT; ENTRY OF DECLARATORY JUDGMENT OF NON-INFRINGEMENT TO BE ENTERED FOR PLAINTIFF AS TO BOTH PATENTS AT ISSUE IN THIS LITIGATION, PURSUANT TO RULE 54(b); ENTRY OF JUDGMENT ON DEFENDANT'S COUNTERCLAIMS TO BE ENTERED FOR PLAINTIFF AND AGAINST DEFENDANT, PURSUANT TO RULE 54(b); CLERK OF COURTS TO WAIT SEVEN (7) DAYS FROM DATE OF THIS DECISION BEFORE FILING ENTRIES OF JUDGMENT

This is a patent case involving the manufacture and sale of two transparent caulking products by Plaintiff Dap Products, Inc. ("Dap"), which are alleged to infringe patents held by Defendant Sashco, Inc. ("Sashco"). In its Complaint (Doc. #1), Plaintiff Dap sues the Defendant upon the following claims for relief: false advertising, in violation of the Lanham Act, 15 U.S.C. § 1125(a) (Count One); deceptive trade practices and unfair competition, in violation of O.R.C. § 4165.01 et seq. and Ohio common law (Count Two); and a request for declaratory judgment of patent invalidity, unenforceability and non-infringement (Count Three). In its Counterclaims (Doc. #29), Defendant Sashco sues the Plaintiff for infringement of its '458 patent in violation of 35 U.S.C. § 271 (Counterclaim One), and infringement of its '014 patent in violation of 35 U.S.C. § 271 (Counterclaim Two).

This Court has federal question jurisdiction over Count One pursuant to 28 U.S.C. § 1331. This Court has original jurisdiction over Count Three pursuant to 28 U.S.C. § 1338, which grants to federal courts exclusive jurisdiction over civil actions relating to patents.[1] Furthermore, this Court has original jurisdiction over Count Two pursuant to 28 U.S.C. § 1338(b), which provides that "[t]he district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent, plant variety protection or trade-mark laws."

Currently pending before this Court are the parties' motions for partial summary judgment and numerous discovery motions. This Court will address the summary judgment motions in detail before turning to the remaining motions.

Defendant has filed, pursuant to Rule 56 of the Federal Rules of Civil Procedure, a Motion for Partial Summary Judgment (Doc. #61) with respect to both of its Counterclaims, Plaintiff's request for a declaratory judgment of non-infringement (Count Three), and Counts One and Two of

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[1] Specifically, this section provides: "The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trade-marks. Such jurisdiction shall be exclusive of the courts of the states in patent, plaint variety protection and copyright cases." 28 U.S.C. § 1338(a).

Plaintiff's Complaint as they relate to acts occurring on or before September 20, 1991. Plaintiff has filed a Motion for Partial Summary Judgment (Doc. #64) with respect to its request for declaratory judgments of non-infringement, invalidity and unenforceability (Count Three), and both of the Defendant's Counterclaims.

In regard to the Defendant's Motion for Partial Summary Judgment as to Counts One and Two of the Plaintiff's Complaint,[2] this Court notes that the Defendant has indicated that the Plaintiff has withdrawn these claims of relief (Doc. #69, p.2). Nothing in the record before this Court shows that these claims have been formally

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[2] Remarks by Defendant's counsel over an open telephone line, before the commencement of a telephone conference with this Court, indicated that counsel was "mystified" by this Court's oral ruling, made prior to the issuance of this opinion, on Counts One and Two. Defendant's counsel apparently forgot that he had, on behalf of the Defendant, requested partial summary judgment on these Counts as to any claim for damages before September 20, 1991. See Doc. #61, p.1 ("Sashco also requests summary judgment that DAP Products' claims against Sashco for alleged false advertising and unfair competition are limited in time to acts after September 20, 1991."). The Court hopes that counsel is no longer mystified as to its ruling on this issue, and, more to the point, that he has learned the lesson that radio personalities have known for generations, to wit: never talk in an audible voice if there is a possibility of an open microphone nearby.

withdrawn by the Plaintiff. However, this Court does note that these Counts were not subsequently briefed by the parties, and, further, that although the Plaintiff had sufficient opportunity to refute the Defendant's assertion regarding the withdrawal of these claims--in both its later pleadings and in the oral argument which was held before this Court on March 1, 1996--Plaintiff did not do so. Therefore, this Court OVERRULES as moot Defendant's Motion for Partial Summary Judgment (Doc. #61) as to Counts One and Two of Plaintiff's Complaint, without prejudice to renewal, and ORDERS the parties to inform this Court, within three (3) days of the date of this decision, as to the status and viability of these claims for relief.

This Court now turns to the remaining claims and counterclaims at issue. For the reasons that follow, this Court concludes that, while there exists a genuine issue of material fact as to the validity and enforceability of the defendant's patents, the Plaintiff's products which are involved in this case do not infringe those patents, as a matter of law. Accordingly, Plaintiff's Motion for Partial Summary Judgment (Doc. #64) is SUSTAINED in regard to its request for a declaratory judgment of non-infringement as to both patents (Count Three) and in regard to the Defendant's Counterclaims, and OVERRULED in regard to its request for a declaratory judgment of invalidity and unenforceability as to the Defendant's patents (Count Three). Concomitantly, Defendant's Motion for Partial Summary Judgment (Doc. #61) is OVERRULED in regard to both of its Counterclaims and in regard to the Plaintiff's request for a declaratory

judgment of non-infringement (Count Three). Finally, in view of the hearing held by this Court on March 1, 1996, in regard to the parties' motions for summary judgment, Plaintiff's Motion for a Hearing (Doc. #62) on the Defendant's Motion for Partial Summary Judgment (Doc. #61) is SUSTAINED, nunc pro tunc March 1, 1996.

Having summarized its conclusions regarding the parties' motions for summary judgment, this Court will now set forth the proper standard for summary judgment, a brief statement of background facts, the relevant law, and the specific reasons for its conclusions. This Court will then turn to the parties' discovery-related motions.

I. Summary Judgment Standard

Before focusing on the merits of the motions, the Court will set forth the relative burdens of the parties once a motion for summary judgment is made. Summary judgment must be entered "against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986).

> Of course, [the moving party] always bears the initial responsibility of informing the district court of the basis of its motion, and identifying those portions of "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any," which it believes demonstrate

the absence of a genuine issue of material fact.

Id. at 323. See also Boretti v. Wiscomb, 930 F.2d 1150, 1156 (6th Cir. 1991) (The moving party has the "burden of showing that the pleadings, depositions, answers to interrogatories, admissions and affidavits in the record, construed favorably to the non-moving party, do not raise a genuine issue of material fact for trial." quoting Gutierrez v. Lynch, 826 F.2d 1534, 1536 [6th Cir. 1987]). The burden then shifts to the non-moving party who "must set forth specific facts showing that there is a genuine issue for trial." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250 (1986) (quoting Fed.R.Civ.P. 56(e)). Thus, "[o]nce the moving party has met its initial burden, the nonmoving party must present evidence that creates a genuine issue of material fact making it necessary to resolve the difference at trial." Talley v. Bravo Pitino Restaurant, Ltd., 61 F.3d 1241, 1245 (6th Cir. 1995). Read together, Liberty Lobby and Celotex stand for the proposition that a party may move for summary judgment by demonstrating that the opposing party will not be able to produce sufficient evidence at trial to withstand a directed verdict motion (now known as a motion for judgment as a matter of law. Fed.R.Civ.P. 50). Street v. J.C. Bradford & Co., 886 F.2d 1472, 1478 (6th Cir. 1989).

Once the burden of production has so shifted, the party opposing summary judgment cannot rest on its pleadings or merely reassert its previous allegations. It is not sufficient to "simply show that there is some metaphysical doubt as to the material facts." Matsushita Elec. Indus.

Co. v. Zenith Radio Corp., 475 U.S. 574, 586 (1986). Rather, Rule 56(e) "requires the non-moving party to go beyond the [unverified] pleadings" and present some type of evidentiary material in support of its position. Celotex Corp., 477 U.S. at 324. Summary judgment "shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed.R.Civ.P. 56(c). Summary judgment shall be denied "[i]f there are . . .'genuine factual issues that properly can be resolved only by a finder of fact because they may reasonably be resolved in favor of either party.'" Hancock v. Dodson, 958 F.2d 1367, 1374 (6th Cir. 1992). Of course, in determining whether a genuine issue of material fact exists, a court must assume as true the evidence of the nonmoving party and draw all reasonable inferences in the favor of that party. Anderson, 477 U.S. at 255 (emphasis added). If the parties present conflicting evidence, a court may not decide which evidence to believe, by determining which parties' affiants are more credible; rather, credibility determinations must be left to the fact-finder. 10A Wright, Miller & Kane, Federal Practice and Procedure, § 2726. In ruling on a motion for summary judgment (in other words, in determining whether there is a genuine issue of material fact), "[a] district court is not . . . obligated to wade through and search the entire record for some specific facts that might support the nonmoving party's claim." Interroyal Corp. v. Sponseller, 889 F.2d 108, 111 (6th Cir. 1989), cert. denied, 494 U.S. 1091 (1990).

See also, L.S. Heath & Son, Inc. v. AT&T Information Systems, Inc., 1993 U.S. App. Lexis 26670 (7th cir. October 12, 1993); Skotak v. Tenneco Resins, Inc., 953 F.2d 909, 915 n. 7 (5th Cir.), cert. denied, 113 S.Ct. 98 (1992) ("Rule 56 does not impose upon the district court a duty to sift through the record in search of evidence to support a party's opposition to summary judgment ...."). Thus, a court is entitled to rely, in determining whether a genuine issue of material fact exists on a particular issue, only upon those portions of the verified pleadings, depositions, answers to interrogatories and admissions on file, together with any affidavits submitted, specifically called to its attention by the parties.

II. Background Facts[3]

This case involves two patents held by Defendant Sashco. United States Patent No. 4,776,458 ("'458 patent") was awarded on October 11, 1988, and describes a transparent container ("cartridge") which dispenses a substantially transparent caulking compound by means of a moveable piston. United States Patent No. 4,863,014 ("'014 patent") was awarded on September 5, 1989, and describes a transparent container ("squeeze tube") with a flexible sidewall

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[3] This Court declines to grant Plaintiff's request that this Court deny Defendant's Motion (Doc. #61) merely because the factual narrative in that motion was not fully supported by authenticating documents, as required by Rule 56. The following narrative is taken from both parties' motions and does not include any facts disputed by the parties.

which allows for manual dispensation of a transparent caulking compound and which has a region of reduced thickness so that the appearance of the substrate[4] surface may be previewed before application. These patents are described in further detail below.

In 1990, a company known as Dap, Inc. ("Old Dap"), which was a wholly-owned subsidiary of USG Corporation ("USG"), began selling a clear, rubber-based compound in a clear cartridge and squeeze tube (Doc. #64, p.4-5). Sashco subsequently sued Old Dap in a Colorado federal court for infringement of its patents (Doc. #61, Exh. E). Two relevant events occurred during litigation. First, Old Dap changed the design of its cartridge to include a non-transparent portion, or mask, around fifty-eight percent of the cartridge's circumference. No change was made to the tube. Sashco did not drop its claim with respect to the cartridge (Doc. #64, p.5). Second, on September 20, 1991, USG sold Old Dap's assets to Wassall, Acquisitions, Inc., which promptly renamed the company "Dap Products, Inc." (Doc. #64, p.5-6; Doc. #61, Exh. G, p.3). Present Plaintiff Dap Products, Inc., continued Old

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[4] "Substrate" is synonymous with "substratum," which is defined as "something that is laid or spread under or that underlies and supports or forms a base for something else." Webster's Third New International Dictionary 2280 (unabridged 1976). This Court assumes that the parties are using the term "substrate" to mean a surface upon which the caulking compound is applied.

Dap's business without interruption (Doc. #64, p.6).

The litigation against Old Dap was resolved on August 20, 1992, by means of a consent decree (Doc. #61, Exh. E). However, Sashco's subsequent attempt to enjoin present Plaintiff Dap from selling the products at issue in this lawsuit was unsuccessful, due to the Colorado court's ruling that Plaintiff was a new, unrelated entity and therefore not bound by the consent decree which resulted from the

Colorado litigation (Doc. #64, p.6 n.17).[5] This lawsuit followed.

A. The '458 Patent (Cartridge)

Sashco filed its original patent application for its cartridge on August 11, 1986. This application contained 29 claims. The first 21 claims were

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[5] This Court notes that the Defendant has not raised the issue of collateral estoppel, which protects a party against whom a claim is asserted "from the burden of litigating an issue that has been fully and fairly tried in a prior action and decided against" the party bringing the claim. Comair Rotron, Inc. v. Nippon Desan Corp., 49 F.3d 1535, 1537 (Fed. Cir. 1995) (citing Blonder-Tongue Laboratories, Inc. v. Univ. of Illinois Foundation, 402 U.S. 313 (1971). In order to assert collateral estoppel, the Defendant would have to "show that in the prior action the [Plaintiff] had a full and fair opportunity to litigate the issue; the issue was actually litigated; the controlling facts and applicable legal rules were the same in both actions; resolution of the particular issue was essential to the final judgment in the first action; and the identical issue was decided in the first action." Id. (citations omitted). In this case, the Plaintiff was not a party to the previous litigation and therefore did not have a full and fair opportunity to litigate the issue of infringement, and, the litigation having ended in a consent decree, that issue was not actually litigated and decided. Accordingly, principles of collateral estoppel are not applicable to this case.

subsequently withdrawn from consideration. Claim 22, which was later redesignated as Claim 1 and is the only independent claim in the patent, was rejected on October 6, 1987, on the ground of obviousness. In a subsequent interview with Sashco's counsel on December 11, 1987, however, the Patent Examiner indicated that the claim "may be allowable if the motivation and the advantage of placing transparent caulk in a transparent container is set forth in the claim other than for viewing contents purposes." (Doc. #64, Exh. F). Sashco amended the Claim accordingly on April 8, 1988, and filed a supplemental amendment on June 10, 1988. The final text of Claim 1 reads as follows:

> A product for use in the building industry, comprising a cartridge formed as an elongated tubular housing having a longitudinal axis and surrounding sidewall fabricated of a transparent material, said housing having a hollow interior, a nozzle member enclosing a downstream end of said cartridge, a substantially transparent caulking compound contained in said cartridge, said caulking compound adapted to be placed on a substrate, and a piston member slideably received in the interior of said cartridge and enclosing an upstream end thereof so that the piston member may be pressed against the caulking compound to force the caulking compound out of said nozzle member as said piston member is moved downstream through said housing

to dispense said caulking material onto said substrate whereby the combination of said housing and said caulking compound is substantially transparent in the transverse direction so as to allow a user to see completely through the surrounding sidewall and through the caulking compound from one side of the cartridge to the other whereby the substrate may be viewed through the combination of the housing and the caulking material placed therein so that the appearance of the substrate as affected by the caulking material may be seen prior to application of the caulking material and whereby the position of the piston member may be viewed as the caulking material is dispensed from the housing.

'458 patent, Claim 1 (emphasis added).

B. The '014 Patent

Defendant Sashco filed a patent application for its squeeze tube on October 7, 1988. This application was granted as filed on September 5, 1989. Claim 1, which is the only independent claim, reads as follows:

A product for the building industry, comprising an elongated container having a longitudinal axis and an interior, said container including a surrounding sidewall, a first closure

forming a downstream end of container and a second closure forming an upstream end of the container, a dispensing nozzle extending outwardly from said container at the downstream end thereof and having a flow passageway in fluid communication with the interior, and a substantially transparent caulking compound contained in the interior of the container, said sidewall being fabricated out of a flexible material whereby the container may be manually squeezed to dispense the caulking compound as an applied bead out of the dispensing nozzle and onto a selected substrate surface, said container having a region of reduced thickness in a direction transverse to the longitudinal axis longitudinally adjacent the upstream end of the container so that the caulking compound in the region of reduced thickness has a substantially uniform, flattened configuration and wherein said sidewall has facing sidewall portions on opposite sides of said region of reduced thickness that are fabricated of substantially transparent material whereby the substrate surface may be viewed through the combination of the facing sidewall portions and the caulking material therebetween so that the appearance of the substrate surface as affected by the caulking material may be

> seen prior to the application of the caulking material.

'104 patent, Claim 1 (emphasis added). In 1993, one of Sashco's competitors filed a request for re-examination which was described by the Patent Examiner as raising a "substantial new question" as to the patentability of this patent's claims and which cited, inter alia, a patent of a clear sealant in a flexible squeeze tube (Doc. #64, Exh. L). Upon re-examination, the Patent Examiner confirmed Sashco's patent upon the following grounds:

> The combination of the transparent caulking compound contained in a transparent type of squeezeable container is old and conventional as clearly evidenced by the reference. However, none of the prior art fairly teaches or suggests the combination as a whole that a transparent type of squeezeable container including transparent caulking compound in a region of a reduced thickness in the transverse direction of the container so that the appearance of a substrate as affected by the caulking material may be seen prior to the application of the caulking material. Such limitation is clearly defined in [Claim 1].... the above mentioned features and their functions are not demonstrated by the prior art.

Remarks of Patent Examiner upon Reexamination, Doc. #64, Exh. I (emphasis added).

Having reviewed the pertinent background facts, this Court now turns to its analysis of Defendant's Counterclaims for infringement (Doc. #29) and Plaintiff's requests for a declaratory judgment as to non-infringement, invalidity and unenforceability (Doc. #1).

III. Infringement

As noted above, Plaintiff sues for a declaratory judgment of non-infringement of the Defendant's patents, and Defendant has counterclaimed for infringement in violation of 35 U.S.C. § 271. Both parties have moved for summary judgment on these claims. After setting forth the general law regarding patent infringement, this Court will turn to the specific patents and products at issue in this litigation.[6]

A. Law on Infringement

In determining whether the Plaintiff's products infringe the Defendant's patents,

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[6] In regard to Plaintiff's Advice to the Court Regarding Submission of Sashco Commercial Products (Doc. #86), this Court notes that it requested these products during a recent telephone conference between Court and counsel for the sole purpose of making certain that it understood the parties' descriptions of the Defendant's products. Although it should be apparent from the reasoning set forth in this opinion, the Court emphasizes that its examination of the Defendant's products played absolutely no role in its analysis of the infringement claims at issue in this lawsuit.

this Court must engage in a two-fold inquiry.

First, this Court must determine the meaning and scope of the patent claims asserted to be infringed. Markman v. Westview Instr. Inc., 52 F.3d 967, 976 (Fed. Cir. 1995), aff'd 116 S.Ct. 1384 (1996). This inquiry, which includes the construction of disputed terms of art contained within the relevant claims, is a question of law exclusively within the province of the court. Markman, 116 S.Ct. at 1384.

Second, the finder of fact must compare the properly construed claims to the device which is alleged to infringe, to determine whether infringement occurred. Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 1269-70 (Fed. Cir. 1986), cert. denied, 479 U.S. 1030 (1987).

In regard to the first inquiry (claim construction), this Court may refer to four distinct sources to determine the meaning of claims: the claims themselves, the specification, the prosecution history, and extrinsic evidence. Markman, 52 F.3d at 979. The Federal Circuit recently provided a useful elaboration of the latter three categories, as follows:

> [Specification]. The specification contains a written description of the invention that must enable one of ordinary skill in the art to make and use the invention. For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms

used in the claims. As we have often stated, a patentee is free to be his own lexicographer. The caveat is that any special definition given to a word must be clearly defined in the specification. The ... specification itself does not delimit the right to exclude. That is the function and purpose of claims.

[Prosecution history]. This "undisputed public record" of proceedings in the Patent and Trademark Office is of primary significance in understanding the claims. The court has broad power to look as a matter of law to the prosecution history of the patent in order to ascertain the true meaning of language used in the patent claims. Although the prosecution history can and should be used to understand the language used in the claims, it too cannot "enlarge, diminish, or vary" the limitations in the claims.

[Extrinsic evidence]. Extrinsic evidence consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises. This evidence may be helpful to explain scientific principles, the meaning of technical terms, and terms of art that appear in the patent and prosecution history.

> Extrinsic evidence is to be used for the court's understanding of the patent, not for the purpose of varying or contradicting the terms of the claims. When, after considering the extrinsic evidence, the court finally arrives at an understanding of the language as used in the patent and prosecution history, the court must then pronounce as a matter of law the meaning of that language.

Markman, 52 F.3d at 980-81 (citations omitted).

In addition to the above guidelines, it is important to note that "dependent claims cannot be found infringed unless the claims from which they depend have been found to have been infringed." Wahpeton Canvas Co. v. Frontier, Inc., 870 F.2d 1546, 1553 (Fed. Cir. 1989). Furthermore, "[i]f an express claim limitation is absent from the accused product, there can be no literal infringement as a matter of law." Woverine World Wide, Inc. v. Nike, Inc., 38 F.3d 1192, 1199 (Fed. Cir. 1994) (citation omitted). Therefore, Plaintiff's cartridge can only infringe Patent 458 if it contains every express limitation contained in Claim 1 (the only independent claim) of that patent; similarly, Plaintiff's squeeze tube can only infringe Patent 014 if it contains every express limitation contained in Claim 1 (the only independent claim) of that patent.

With the above principles in mind, this Court now turns to its analysis of each of the Defendant's patents.

B. Infringement of the '458 Patent

1. Claim Construction

The first step in the analysis is to determine, as a matter of law, the meaning and scope of the patent claims. As described above, Defendant Sashco's '458 patent is directed to a substantially transparent combination of a cartridge and compound. The only independent claim in the patent emphasizes that this combination "is substantially transparent in the transverse direction so as to allow a user to see completely through... from one side of the cartridge to the other." This Court must now determine whether this claim, when properly construed, is limited to situations wherein a user can see through the center of the cartridge, as argued by the Plaintiff, or whether it encompasses situations in which a user can see completely through any other portion of the cartridge's sidewall, which is the construction urged by the Defendant.[7]

Before turning to extrinsic evidence and the prosecution history of the patent, this Court must first address a problematic aspect of the above-quoted language. This

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[7] For example, Defendant attached pictures to its Motion for Partial Summary Judgment which showed that one can view through the Plaintiff's product and see a colored line which is taped to the wall behind the cartridge (Doc. #61, Exh. J). One cannot, however, view the colored line through the center of the cartridge; instead, the line can only be seen through less than half of the right side of the cartridge.

claim describes a cylindrical cartridge[8] that is substantially transparent in the transverse direction so that a user may see from one "side" of the cartridge to the other. Since this description apparently refers to a "circular cylinder"--that is, to a cylinder whose bases are circles, Webster's New World Dictionary of Mathematics, 31 (1989)--it is most helpful to think about this description in terms of circles.

Unfortunately, however, a circle has no "sides." Unlike other geometrical figures which are defined in terms of the number of sides they possess[9] and their relation to each other,[10] a circle is

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[8] The specification describes the container as consisting of "a tubular housing having first and second closing structures at opposite ends." The term "tube" is defined as "a hollow, elongated, usually cylindrical body." Webster's Third New International Dictionary 2459 (unabridged 1976).

[9] A polygon is defined as "a closed path of connecting line segments AB, BC, ... [which are termed] the sides of the polygon." Webster's New World Dictionary of Mathematics 200 (1989). Polygons are named according to the number of their sides: a triangle has three sides; a quadrilateral, four; a pentagon, five, and so on. Id.

[10] For example, quadrilaterals, which are four-sided polygons, are classified by the parallelism of their sides: "the figures is a trapezium, trapezoid, or parallelogram depending upon whether no,

defined as "a plane curve consisting of all points at a given distance from a given point." Webster's New World Dictionary of Mathematics 30 (1989). Moreover, the term "side" is defined as "the bounding line of a geometrical figure," Webster's Third New International Dictionary 2111 (unabridged 1976), and in ordinary Euclidean geometry a "line" is conceived of as being straight and of unlimited extent. Webster's New World Dictionary of Mathematics, 156-57 (1989). Therefore, the claim's reference to seeing "from one side of the cartridge to the other" is less helpful than might initially be supposed.[11] Accordingly, this Court's analysis will focus instead upon the meaning of the phrase "substantially transparent in the transverse direction."

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one, or two pairs of opposite sides are parallel, respectively. A rectangle is a parallelogram with all angles equal, and a square is a rectangle with all sides equal." Webster's New World Dictionary of Mathematics 218-19 (1989).

[11] Having demonstrated that the term "side" is a misnomer when used in reference to a circular cylinder, this Court will nevertheless observe that the expression "from one side to the other" clearly describes a point opposite the point of origin. Therefore, had this Court relied upon this expression to construe the claim, it would have concluded that this phrase indicates that a user must be able to see through the center of the cartridge to the opposite point of the cartridge, as opposed to merely being able to view a point which is an infinitesimal distance away.

Relying upon its authority to look to extrinsic evidence for assistance in construing the meaning of this claim, this Court will turn first to the dictionary. The definition of "transverse" is "extended or lying across or in a crosswise direction." Webster's Third New International Dictionary 2431 (unabridged 1976). The term "across" is defined as "to or on the opposite side." Id. at 20. Although this might appear merely to bring this Court to its earlier observation that a cylindrical cartridge does not have sides, the term "opposite" is a useful addition, suggesting that a user must see through the central longitudinal axis[12] of the cartridge in order to view the opposite point (rather than side) of the cartridge, exactly one hundred and eighty degrees on the circle from the initial point.[13]

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[12] The term "central longitudinal axis" is arguably a redundancy, as the term "axis" refers to "a straight line bout which a body or three-dimensional figure rotates or may be supposed to rotate." Webster's Third New International Dictionary 153 (unabridged 1976). Presumably, therefore, the Defendant's cylindrical cartridge has only one longitudinal axis, located in the center of the cartridge. However, given that the parties have disputed this point, this Court will employ the term "central longitudinal axis" for purposes of clarity.

[13] Of course, given that the object discussed here is a three-dimensional cylinder rather than a two-dimensional circle, the user need not confine himself to looking directly across the cartridge in order to view "in the transverse

This initial conclusion is buttressed by a further observation. Given that a circle (and thus a cylindrical cartridge) has no sides, there are only two possible ways to construe the phrase "in the transverse direction": either it describes a direction extending toward the opposite point of the cartridge, exactly one hundred and eighty degrees on the circle from the initial point, or it describes a direction extending toward any point of the cartridge, including a point just an infinitesimal distance away. The first construction appears to be the most logical choice, for two reasons.

First, the phrase "in the transverse direction" appears to refer to a particular, measurable direction, as opposed to any of numerous possible directions which would intersect any point of the cartridge, including points just an infinitesimal distance away. If this were not the case, the patent could have simply used the term "in any direction and for any distance."

Second, the latter construction, somewhat incongruously, would allow the Defendant's patent to encompass any cartridge which is substantially non-transparent, but which has a viewing window large enough to permit the user to see "through" the cartridge to any other point on the cartridge. This construction is

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direction," but may also look toward any point directly above or below the opposite point on the cartridge. The common denominator is that the user must look through the central longitudinal axis in order to view any of these points.

belied by both the prosecution history and the claim itself. As discussed earlier, the Patent Examiner initially rejected Claim 1 for obviousness but later indicated that it "may be allowable if the motivation and the advantage of placing transparent caulk in a transparent container is set forth in the claim other than for viewing contents purposes." Defendant Sashco amended its claim accordingly to reflect the following advantages realized by its product:

> the substrate may be viewed through the combination of the housing and the caulking material placed therein so that the appearance of the substrate as affected by the caulking material may be seen prior to application of the caulking material and [] the position of the piston member may be viewed as the caulking material is dispensed from the housing.

'458 patent, Claim 1. These advantages--allowing the substrate, as it will be affected by the caulking material, to be viewed prior to applying that caulking material, and viewing the piston as the material is applied--would appear to require more transparency than that which can be provided by a viewing window, which may or may not allow one to directly "line up" the cartridge with the surface of the item to which the caulking compound is to be applied, so as to enable one to see how that surface will look once that compound is so applied. In any event, given the prosecution history described above, there must be some appreciable difference between Defendant Sashco's product and a product

which merely allows the user to view the contents. Accordingly, this Court will not construe this Claim as encompassing all substantially non-transparent cartridges which have a large viewing window.

For the foregoing reasons, this Court will interpret the phrase "in the transverse direction" to mean toward the opposite point of the cartridge (i.e. one-hundred and eighty degrees from the initial point), and toward all points which are directly above and below that point. This construction necessarily limits the patent to situations wherein the user may view directly through the central longitudinal axis of the cartridge.[14]

There is another reason why this construction of the patent's claim must be the correct one. The claim emphasizes that the "substrate may be viewed through the combination of the housing and the caulking material placed therein so that the appearance of the substrate as affected by the caulking material may be seen prior to application of the caulking material." This result can only be achieved if a user is able to see the area directly beneath and below the nozzle (which extends from the very center of the top of the cartridge), away from the piston, because

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[14] This Court notes here that it has reviewed the deposition testimony of Plaintiff's expert, Richard Killworth, which was cited by the Defendant in its Motion (Doc. #61) and which discusses the interpretation of both of the patents at issue here. This Court concludes that this testimony does not refute or undermine the Plaintiff's arguments.

this is the area to which the caulking material will be applied. As a practical matter, therefore, a user who wishes to view the substrate through the cartridge (as opposed to looking directly at the substrate surface by angling his or her head), will position himself or herself at the opposite end of the cartridge, so that he or she is "lined up" with the nozzle. From this position, he or she must look through the central longitudinal axis of the cartridge so as to view the substrate to which the caulking material will be applied. Importantly, a mere ability to see through any other portion of the cartridge--which, of necessity, would put the viewer's line of sight at an angle with the substrate and the piston--would not allow one to view the area directly below the nozzle, which is the area of the substrate to which the caulking material will be applied. Thus, the claim's asserted function can only be realized if the user is able to view directly through the central longitudinal axis of the cartridge.

As a final matter, this Court notes that the claim's requirement that the "position of the piston member may be viewed as the caulking material is dispensed from the housing" can be fairly interpreted as supporting its construction of the patent's claim. In regard to this function, the crucial issue is whether a partial view of the edge of the piston (as is provided by the Plaintiff's cartridge, due to the existence of an opaque mask which obscures 58% of the cylinder) is sufficient to fulfill this function, or whether a view of more than fifty percent of the piston member--which necessarily is only achievable if any existing mask

obscures less than 50% of the cylinder, so that a user can view directly through the central longitudinal axis of the cartridge--is required.

The answer to this issue would appear to depend upon the physical configuration of the piston member. For example, if the piston member is merely a flat base, a failure to exert pressure directly in the center of the piston might cause the piston member to slide unevenly, thus requiring a view of more than half of the piston member in order to determine the precise extent of the unevenness and the resulting position of the piston member. If, however, the piston member is "cup-shaped in configuration so that it has a flat base plate [] which bears against caulking material," as is described in the Defendant's preferred embodiment, then the piston member should slide evenly, thereby allowing a user to be certain of the precise position of the entire piston member <u>even if</u> he or she has only a partial view of said piston.

Accordingly, this Court must inquire as to whether the Defendant's patent is necessarily limited to piston members which have cup-shaped configurations. In this regard, the Court notes that the only part of the patent which describes the piston member as having a "cup-shaped configuration" is the patent's description of the preferred embodiment. However, language in the patent which immediately precedes the claim clearly reflects the Defendant's intent <u>not</u> to limit its patent to the description of its preferred embodiment:

> [T]he present invention has been described with some degree of particularity directed to the preferred embodiment of the present invention. It should be appreciated, though, that the present invention is defined by the following claims construed in light of the prior art so that modifications or changes may be made to the preferred embodiment of the present invention without departing from the inventive concepts contained herein.

Moreover, the Federal Circuit has "cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification." Texas Instr. v. United States Int'l Trade Comm'n, 805 F.2d 1558, 1563 (Fed. Cir. 1986); accord Laitram Corp. v. Cambridge Wire Cloth Co., 863 F.2d 855, 865 (Fed. Cir. 1988) ("References to a preferred embodiment, such as those often present in a specification, are not claim limitations"), cert. denied, 490 U.S. 1068 (1989). Therefore, this Court will not construe the Defendant's patent as being limited to piston members with cup-shaped configurations. Instead, this Court will construe the patent as encompassing other possible configurations of the piston member, including a flat base which may slide unevenly if pressure is not applied to the direct center of the piston member. In such a case, the user's need to view more than half of the piston member in order to determine the precise extent of the unevenness and the resulting position of the piston member, supports this Court's construction of the Defendant's claim to be

limited to situations wherein the user may view directly through the central longitudinal axis of the cartridge.

2. Comparison of Claim 1 to Plaintiff's Cartridge

The next step in the analysis is to compare the properly construed claim to the product which is alleged to infringe the patent, in order to determine whether infringement has occurred. Although this is a factual question, this Court may, upon a motion for summary judgment, determine whether there exists any genuine issue of material fact on this issue.

This Court has held that the Defendant's patent is limited to situations wherein a user can view directly through the central longitudinal axis of the cartridge, toward the opposite point and/or points above and below that point. Here, it is undisputed that the Plaintiff's product contains a mask which obscures approximately 58% of the cartridge. Given this limitation, no reasonable jury could conclude that a user could view directly through the central longitudinal axis of the Plaintiff's cartridge, as there is no point on the cartridge from which a user could look through to a point one-hundred and eighty degrees away without viewing the opaque mask.[15] In short, it would be a

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[15] Although this Court can look through the opaque mask and discern the outline and color of objects which are placed next to the mask, this does not satisfy the patent's requirement that "the combination of said housing and said caulking compound is substantially

physical impossibility for a user to have a line of sight such as to be able to view both how the surface to which the caulking compound will be applied will be affected, and the position of the piston member. Therefore, this Court finds that there exists no genuine issue of material fact as to this question, and instead holds as a matter or law that the Plaintiff's product does not infringe Defendant Sashco's '458 patent.[16]

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transparent in the transverse direction so as to allow a user to see completely through the surrounding sidewall.... " (Patent '458, Claim 1). The term "transparent" is defined as "having the property of transmitting light without appreciable scattering so that bodies lying beyond are entirely visible." Webster's Third New International Dictionary 2430 (unabridged 1976). In contrast, the term "translucent" is defined as "admitting and diffusing light so that objects beyond cannot be clearly distinguished: partly transparent." Id. at 2429.

[16] Under the doctrine of equivalents, infringement may be found where the patent holder "show[s] the presence of every element [of a claim] or its substantial equivalent in the accused device." Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 935 (Fed. Cir. 1987), cert. denied, 485 U.S. 961 (1988). Due to the parties' failure to raise, argue or brief the doctrine of equivalents, this Court will not reach the issue of whether the Plaintiff's products infringe Defendant Sashco's patents under this doctrine, and will rule only that there is no literal infringement of the patents. Although

Accordingly, Plaintiff's Motion for Partial Summary Judgment (Doc. #64) is SUSTAINED both as to that portion of Count Three which requests a declaration of non-infringement of the Defendant's '458 patent, and as to Counterclaim One. Conversely, Defendant's Motion for Partial Summary Judgment (Doc. #61) is OVERRULED both as to Counterclaim One, and as to that portion of Count Three which requests a

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mindful of the Federal Circuit's statement that "[t]he trial judge does not have discretion to choose whether to apply the doctrine of equivalents when the record shows no literal infringement," Hilton Davis Chem. Co. v. Warner-Jenkinson Co., Inc., 62 F.3d 1512, 1522 (Fed. Cir. 1995), cert. granted, 116 S.Ct. 1014 (1996), and the resulting implication that courts must consider the doctrine of equivalents, this Court does not believe that the Federal Circuit would require trial courts to apply the doctrine where it is not raised or argued by the parties themselves.

In any event, if this Court were to reach the issue, it would hold merely that summary judgment for the Plaintiff is proper because the Defendant, which bears the burden of proof on the issue at trial, has failed to create a genuine issue of material fact as to whether the Plaintiff's products infringe under the doctrine of equivalents. See Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1389 (Fed. Cir. 1992) (affirming grant of summary judgment to the plaintiff where the defendant, a non-movant on the non-infringement issue, failed to provide evidence of a necessary element of the doctrine of equivalents).

declaration of non-infringement of the Defendant's '458 patent.

C. Infringement of the '014 Patent

1. Claim Construction

This Court now turns to Defendant Sashco's '014 patent, which describes a transparent squeeze tube that has a region of reduced thickness which allows the substrate to be viewed prior to application of the compound. The specific portion of Claim 1, the only independent claim, implicated in this case is the statement that "the compound in the region of reduced thickness has a substantially uniform, flattened configuration." Plaintiff argues that this requirement does not encompass its product, which is best described as a toothpaste-type squeeze tube. Defendant argues that its patent does extend to toothpaste-type tubes, similar to the product marketed by the Plaintiff.

As before, this Court will use the dictionary as a starting point for its analysis, focusing on the requirement that the caulking compound in the specified region have a "substantially uniform, flattened configuration." The term "flat" is defined as "having or marked by a continuous surface that is horizontal or nearly so without significant curvature or inclination." Webster's Third New International Dictionary 865 (unabridged 1976). The term "flattened" means "reduced to an even or more nearly even surface." Id. at 867. Therefore, a straightforward interpretation of this claim requires the slope or inclination of the tube to be noticeably reduced in this particular region, so that the surface of the tube

(and the compound within it) becomes more horizontal and even. Accordingly, a toothpaste tube which does not have an appreciably "flattened" region, but which merely has an unchanging, tapered slope from one end of the tube to the other, will not fall within this patent's definition.

This interpretation of "flattened" is supported by specific language in the patent's specification, which describes this region as "a packet of caulking compound [having] a uniform dimensional thickness to facilitate preview of the caulking compound. . . [which] may be generally a rectangular pillow of caulking material. . . . [which] allows the transparent facing sidewall portions to be oriented substantially parallel to one another to reduce distortion when the substrate surface is viewed." See also Figure 2 (demonstrating that letters of words may be viewed through this region of the product without significant distortion). These descriptions, taken either separately or together, indicate that the region of reduced thickness described in the patent is indeed intended to be "flattened" by having less of a slope (and, ideally, no slope) than the remainder of the tube. Simply put, these descriptions do not describe a toothpaste tube.

Bearing this construction in mind, this Court now turns to an examination of the Plaintiff's tube to determine if there exists a genuine issue of material fact as to whether this product infringes the Defendant's patent.

2. Comparison of Claim 1 to Plaintiff's Squeeze Tube

As before, the next step in this Court's analysis is to compare the properly construed claim to the product which is alleged to infringe the patent, in order to determine whether infringement has occurred. Upon even a cursory examination of the Plaintiff's squeeze tube, it becomes quite clear that there is no flattened region at the end of the tube, as that term is understood and used within the context of Defendant Sashco's patent.[17] Instead, the Plaintiff's tube slopes from one end to the other. Therefore, since no reasonable jury could conclude that Plaintiff's tube contains the flattened region specified in the Defendant's patent, there exists no genuine issue of material fact as to the issue of whether Plaintiff's squeeze tube infringes Defendant's '014 patent. Accordingly, Plaintiff's Motion for Partial Summary Judgment (Doc. #64) is SUSTAINED both as to that portion of Count Three which requests a declaration of non-infringement of the Defendant's '014 patent, and as to Counterclaim Two. Conversely, Defendant's Motion for Partial Summary Judgment (Doc. #61) is OVERRULED both as to Counterclaim Two, and as to that portion of Count Three which requests a

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[17] For the record, this Court notes that the plastic strip at the very end of the tube--which contains no caulking compound and appears merely to serve the function of allowing the tube to be hung up in the store--is not the flattened region defined in the Defendant's patent.

declaration of non-infringement of the Defendant's '014 patent.

IV. Invalidity and Unenforceability

As noted above, Plaintiff sues for a declaratory judgment that the Defendant's patents are invalid and unenforceable, and has moved for summary judgment on this claim. Although this Court has now held, as matter of law, that the Plaintiff's products do not infringe the patents at issue in this lawsuit, the relevant case law indicates that this ruling does not automatically divest this Court of jurisdiction[18] over Plaintiff's claims of

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[18] The existence of the Court's jurisdiction in this context depends upon whether the litigants satisfy the case of controversy requirement of Article III of the United States Constitution. in upholding the constitutionality of the Declaratory Judgment Act, 28 U.S.C. §2201, the Supreme Court set forth the following principles relating to a court's jurisdiction under the Act:

> A "controversy" in this sense must be one that is appropriate for judicial determination. A justiciable controversy is thus distinguished from a difference or dispute of a hypothetical or abstract character. . . . The controversy must be definite and concrete, touching the legal relations of parties having adverse legal interests. It must be a real and substantial controversy admitting of specific relief through a decree

invalidity. After briefly setting forth this law, this Court will proceed to consider whether there exists a genuine issue of material fact as to these claims.

As a general matter, the Supreme Court has made clear its preference that in suits for patent infringement the district court inquire fully into the issue of the patent's validity. Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327 (1945), quoted with approval in Cardinal Chemical Co. v. Morton Int'l, Inc., 113 S.Ct. 1967, 1977 (1993). Importantly, whether a district court retains jurisdiction to consider the issue of a patent's validity after it has determined that the patent at issue was not infringed, depends upon the manner in which the claim of invalidity was asserted. Where invalidity is asserted as an affirmative defense to the adverse party's claim of infringement, a finding of non-infringement automatically divests the court of jurisdiction to consider the issue of invalidity, due to the resolution of the claim. See Deposit Guaranty Nat'l Bank v. Roper, 445 U.S. 326, 335 n.7 (1980) (explaining that the district court "was incorrect to adjudge the patent valid after ruling that there had been no infringement" as this "decided a hypothetical controversy") (citing Thomas & Betts Co. v. electrical Fittings Corp., 23 F. Supp. 920 (S.D.N.Y. 1938)). If, however, one of the parties has sought a declaratory judgment as to the validity or invalidity of the

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of a conclusive character. . . .

Aetna Life Ins. Co. v. Haworth, 300 U.S. 227, 240-41 (1937).

patent, a finding of non-infringement will not automatically resolve this separate claim. Altvater v. Freeman, 319 U.S. 359, 363 (1943) ("Though the decision of non-infringement disposes of the bill and the answer, it does not dispose of the counterclaim which raises the question of validity.").

In this case, because Plaintiff Dap has brought a separate claim for declaratory judgment of the invalidity and unenforceability of the Defendant's patents, this Court's finding of non-infringement of those patents does not automatically divest it of jurisdiction to consider the issue of invalidity. While there is an absence of any briefing by the parties as to the nature and extent of their interests in the sole remaining issue of invalidity, in view of the Supreme Court's strong preference that district courts "fully inquire" into the issue of invalidity, this Court will proceed to rule upon the Plaintiff's Motion for Partial Summary Judgment on that issue.

Accordingly, this Court now turns to the aforesaid motion to determine whether there exists a genuine issue of material fact as to the alleged invalidity and unenforceability of the Defendant's patents. After setting forth the applicable law, this Court will turn to the specific patents and products at issue here.

A. Law on Invalidity (Best Mode)

Under 35 U.S.C. §282, patents are presumed to be valid. Therefore, a party asserting invalidity must establish such a claim by clear and convincing evidence.

United States Gypsum Co. v. National Gypsum Co., 74 F.3d 1209, 1212 (Fed. Cir. 1996). A patent may be invalid if it fails to comply with the best mode requirement, which requires the specification to "set forth the best mode contemplated by the inventor of carrying out his invention." 35 U.S.C. §112.

It is well-settled that a best mode analysis has two elements. First, the fact-finder must engage in a subjective inquiry to determine whether the inventor "knew of a mode of practicing his invention at the time he filed his patent application which he considered to be better than any other." In re Hayes Microcomputer Prod., Inc. Patent Litigation, 982 F.2d 1527, 1536 (Fed.Cir. 1992) (citing Chemcast Corp. v. Arco Indus. Corp., 913 F.2d 923, 927 (Fed. Cir. 1990)). Second, if the inventor did have a best mode, the fact-finder must engage in an objective inquiry to determine "whether de disclosed it and did so adequately to enable one of ordinarily skill in the art to practice the best mode." Id. These inquiries are treated as questions of fact. Chemcast Corp., 913 F.2d at 928.

Before this analysis can be applied, however, it is necessary to delimit the scope of the claimed invention. The Federal Circuit has clarified that the best mode requirement applies only to the claimed invention: "Unclaimed subject matter is not subject to the disclosure requirements of §112; the reasons are pragmatic: the disclosure would be boundless, and the pitfalls endless." Engel Indus., Inc. v. Lockformer Co., 946 F.2d 1528, 1531 (Fed. Cir. 1991). This principle was recently emphasized by the

Federal Circuit in a best mode case involving a patented interferometer that was sold in an encasement not claimed in the patent:

> At least one of the inventors contributed to the commercial design. The failure to disclose the commercial mode, however, does not ipso facto result in a section 112 violation. The focus of a section 112 inquiry is not what a particular user decides to make and sell. . . . Rather, in keeping with the statutory mandate, our precedent is clear that the parameters of section 112 inquiry are set by the CLAIMS.

Zygo Corp. v. Wyko Corp., 79 F.3d 1563, 1567 (Fed. Cir. 1996) (emphasis in original).[19] Because this issue depends upon interpretation of the scope of the claims set forth in the patent, it is an issue for this Court to decide. See Markman v. Westview Instr., Inc., 116 S.Ct. 1384, 1387 (1996) (holding that "the construction of a patent. . . is exclusively within the province of the court").

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[19] This Court notes here the similarity between this principle, which applies to purported best mode violations, and the principle that courts should decide whether infringement has occurred "by comparing the accused device with the claims in suit, not with a preferred or commercial embodiment of the patentee's claimed invention." Martin v. Barber, 755 F.2d 1564, 1567 (Fed. Cir. 1985).

B. Validity of Defendant's Patents

Plaintiff asserts that both of Defendant Sashco's patents are invalid because the inventor failed to disclose the best mode. In regard to the '458 patent, Plaintiff argues that the inventor preferred to use compound from one particular company in its cartridge, but failed to disclose the name of source of this compound (Doc. #64). In regard to the '014 patent, Plaintiff claims that the Defendant manufactured its own compound for use in its squeeze tube, but failed to disclose the components and qualities of that product (Doc. #64). As noted, before turning to the two-step analysis to determine whether there exists a genuine issue of material fact as to this claim, this Court must first discuss the scope of the Defendant's patents.

The pertinent issues in this initial inquiry are whether the Defendant's patents--which describe a combination of a transparent cartridge or squeeze tube with transparent compound--required the inventor to disclose either the brand-name of the compound which he preferred to use in his cartridge, or the particular formulation of the compound which he preferred to use in his squeeze tube. On this point, the Federal Circuit has provided the following useful analysis:

> A description of particular materials or sources or of a particular method or technique selected for manufacture may or may not be required as part of a best mode disclosure respecting a device. Thus, the particulars of making a prototype or even a

commercial embodiment do not necessarily equate with the "best mode" of "carrying out" an invention. Indeed, the inventor's manufacturing materials or sources or techniques used to make a device may vary from wholly irrelevant to critical.

For example, if the inventor develops or knows of a particular method of making [his product] which substantially improves the operation or effectiveness of his invention, failure to disclose such peripheral development may well lead to invalidation. On the other had, an inventor is not required to supply "production" specifications. . . . [T]here is no mechanical rule that a best mode violation occurs because the inventor failed to disclose particular manufacturing procedures beyond the information sufficient for enablement.

One must look at the scope of the invention, the skill in the art, the evidence as to the inventor's belief, and all of the circumstances in order to evaluate whether the inventor's failure to disclose particulars of manufacture gives rise to an inference that he concealed information which one of ordinary skill in the art would not know.

Wahl Instr., Inc. v. Acvious, Inc., 950 F.2d 1575, 1580 (Fed. Cir. 1991). Furthermore, in discussing the "production specifications" exception to the best mode requirement, the Federal Circuit has stated that

> the best mode requirement does not require an inventor to disclose production details so long as the means to carry out the invention are disclosed. This includes providing supplier/trade name information where it is not needed, i.e., where such information would be "mere surplusage--an addition to the generic description." Such supplier/trade name information must be provided only when a skilled artisan could not practice the best mode of the claimed invention absent this information.

Transco Procs. Inc. v. Performance Contracting, Inc., 38 F.3d 551, 560 (Fed. Cir. 1994), cert. denied, 115 S.Ct. 1102 (1995) (emphasis added).

These legal guidelines indicate that this Court must examine all of the factual circumstances in order to determine whether the use of a particular brand or formulation of compound either "substantially improved" the operation of Defendant's products or was a mere "production specification." Because some of these circumstances are in dispute (e.g., the inventor's state of mind), and because others have not yet ben addressed by the parties (e.g., whether a skilled artisan could manufacture the cartridge

without knowledge of a particular brand-name of compound), this inquiry cannot be resolved upon this motion for summary judgment. Therefore, Plaintiff's Motion for Partial Summary Judgment (Doc. #64) is OVERRULED in regard to that portion of Count Three which requests a declaration of invalidity and unenforceability of Defendant's patents.[20]

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[20] This Court will make two points here. First, the Court notes for the record that the Defendant did not move for summary judgment in regard to that portion of Count Three of Plaintiff's Complaint which requests a declaration of invalidity and unenforceability of Defendant's patents.

Second, the Court notes that although the Supreme Court has not directly addressed the nature and extent of a district court's jurisdiction in a case such as this one--namely, where a plaintiff who is seeking declaratory judgments of non-infringement and invalidity has been awarded the former but not the latter upon a motion for summary judgment--it has pointed out that "the Declaratory Judgment Act affords the district court some discretion on determining whether or not to exercise that jurisdiction, even when it has been established." Cardinal Chemical Co., 113 S.Ct. at 1974 n.17. Therefore, even if the Plaintiff succeeds in establishing this Court's jurisdiction over the sole remaining issue of invalidity, the continuing viability of Plaintiff's request for a declaratory judgment as to the invalidity and unenforceability of the Defendant's paterts is not assured.

V. Remaining Discovery Motions

Having determined that the Plaintiff's products which are at issue in this litigation do not infringe either of the Defendant's patents, this Court now turns to the discovery motions which are currently pending in this case. Because all of these motions deal exclusively with the issue of the Plaintiff's alleged infringement--which is no longer a viable issue in this litigation--they are all overruled as moot.

Three of the motions involve the Defendant's refusal to allow Mark Bross, who was the draftsman for the '014 patent, to answer certain questions in his deposition regarding the interpretation and infringement of that patent. In light of this Court's ruling that Plaintiff's squeeze tube did not, as a matter of law, infringe this patent, these questions are no longer relevant to this litigation. Therefore, the following motions are OVERRULED as moot: Plaintiff's Motion to Compel Defendant's Expert Witness to answer certain deposition questions (Doc. #66); Plaintiff's alternative Motion to Strike Mr. Bross as an Expert Witness (Doc. #66); and Defendant's Motion for a Protective Order (Doc. #72).

Similarly, the Plaintiff's failure to answer written interrogatories relating to the number of allegedly infringing sales of cartridges and squeeze tubes are no longer relevant, as these interrogatories go solely to the issue of damages for the alleged infringement, which are no longer an issue in this case. Accordingly, Defendant's Motion to Compel the Plaintiff to Answer Interrogatories (Doc. #78) is

OVERRULED as moot. For the same reasons, Plaintiff's Motion to Exclude Evidence of Defendant's New Damage Theories (Doc. #74) is also OVERRULED as moot.

VI. Further Procedures to Resolve this Litigation

In a conference held between Court and counsel, it was suggested that the most logical next step in this litigation is to enter partial judgment for the Plaintiff on the issue of infringement under Rule 54(b),[21] so that the parties may appeal

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[21] This Rule, which is captioned "Judgment Upon Multiple Claims or Involving Multiple Parties," reads as follows:

> When more than one claim for relief is presented in an action, whether as a claim, counterclaim, cross-claim, or third-party claim, or when multiple parties are involved, the court may direct the entry of a final judgment as to one or more but fewer than all of the claims or parties only upon an express determination that there is no just reason for delay and upon an express direction for the entry of judgment. In the absence of such determination and direction, any order or other form of decision, however designated, which adjudicates fewer than all the claims or the rights and liabilities of fewer than all the parties shall not terminate the action as to any of the claims or parties, and the order or other form of decision is subject to revision at any time before the entry of judgment adjudicating all the

that issue before determining the nature and extent of their interests in going to trial on the issue of invalidity. During this conversation, Plaintiff's counsel indicated that his client's only interest in adjudicating the issue of invalidity, assuming that the Court's determination of non-infringement of both patents is upheld on appeal, is in future possibilities of redesigning its cartridge. This appears to the Court to be, at best, a hypothetical or academic interest. Moreover, both parties indicated that they believe they can settle the issue of invalidity amicably when the issue of infringement is resolved. Finally, allowing entry of judgment pursuant to Rule 54(b) would further the Court's interest in conserving judicial resources which might otherwise be expended on a trial ultimately regarded as unnecessary by both of the parties. For these reasons, this Court finds that there is no just reason for delay, and therefore ORDERS that judgment be entered for the Plaintiff and against the Defendant on the issue of infringement, pursuant to Rule 54(b). The Clerk of Courts is instructed to wait seven (7) days from the date of this decision before filing said judgment, in order to allow counsel to object to the entry of judgment pursuant to Rule 54(b).

WHEREFORE, based upon the aforesaid, Defendant's Motion for Partial Summary Judgment (Doc. #61) is OVERRULED as to its Counterclaims and Count Three of Plaintiff's Complaint. The aforesaid

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> claims and the rights and liabilities of all the parties.

Rule 54(b).

Motion is OVERRULED as moot, without prejudice to renewal, in regard to Counts One and Two of Plaintiff's Complaint.

Plaintiff's Motion for Hearing (Doc. #62) on said motion (Doc. #61) is SUSTAINED, nunc pro tunc March 1, 1996.

Plaintiff's Motion for Partial Summary Judgment (Doc. #64) is OVERRULED in regard to its request in Count Three for a declaratory judgment of invalidity and unenforceability as to both patents. The aforesaid Motion is SUSTAINED in regard to its request for a declaratory judgment of non-infringement as to both patents.

The following motions are OVERRULED as moot: Plaintiff's Motion to Compel Defendant's Expert Witness to answer certain deposition questions (Doc. #66); Plaintiff's alternative Motion to Strike Mr. Bross as an Expert Witness (Doc. #66); Defendant's Motion for a Protective Order (Doc. #72); Plaintiff's Motion to Exclude Evidence of Defendant's New Damage Theories (Doc. #74); and Defendant's Motion to Compel the Plaintiff to Answer Interrogatories (Doc. #78).

The parties are ORDERED to inform this Court, within three (3) days of the date of this decision, of the status and viability of Counts One and Two of the Plaintiff's Complaint.

A declaratory judgment of non-infringement of Defendant's '458 patent and Defendant's '014 patent is ORDERED to be entered, pursuant to Rule 54(b), in favor of the Plaintiff and against the Defendant, as there is no just reason for delay. The Clerk of Courts is instructed to wait seven

(7) days from the date of this decision before filing said judgment, in order to allow counsel to object to the entry of judgment pursuant to Rule 54(b).

Judgment on the Defendant's Counterclaims is ORDERED to be entered, pursuant to Rule 54(b), in favor of the Plaintiff and against the Defendant, as there is no just reason for delay. The Clerk of Courts is instructed to wait seven (7) days from the date of this decision before filing said judgment, in order to allow counsel to object to the entry of judgment pursuant to Rule 54(b).

July 17, 1996

s/_____
WALTER HERBERT RICE
UNITED STATES DISTRICT JUDGE

Copies to:

David A. Shough, Esq.
Charles J. Faruki, Esq.
Jerome C. Randolph, Esq.
Timothy J. Martin, Esq.
Susan R. Fox, Esq.

APPENDIX B

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

NOTICE OF ENTRY OF
JUDGMENT WITHOUT OPINION

JUDGMENT ENTERED: 04/14/97

The judgment of the court in your case was entered today pursuant to Rule 36. This Court affirmed the judgment or decision that was appealed. None of the relief sought in the appeal was granted. No opinion accompanied the judgment. The mandate will be issued in due course.

Information is also provided about petitions for rehearing and suggestions for rehearing in banc. The questions and answers are those frequently asked and answered by the Clerk's Office.

Costs are taxed against the Appellant(s) in favor of the Appellee(s) under Rule 39. The party entitled to costs is provided a bill of costs form and an instruction sheet with this notice.

The parties are encouraged to stipulate to the costs. A bill of costs will be presumed correct in the absence of a timely filed objection.

Costs are payable to the party awarded its costs. If costs are awarded to the government, they should be paid to the Treasurer of the United States. Where costs are awarded against the government, payment should be made to the person(s)

designated under the governing statutes, the court's orders, and the parties' written settlement agreements. In cases between private parties, payment should be made to counsel for the party awarded costs or, if the party is not represented by counsel, to the party made to counsel for the party awarded costs or, if the party is not represented by counsel, to the party pro se. Payment of costs should not be sent to the court. Costs should be paid promptly.

Exhibits and visual aids shall be promptly retrieved by the party that lodged them with the court.

JAN HORBALY
Clerk

cc: TIMOTHY J. MARTIN
PAUL GERARD HALLINAN

DAP PRODUCTS V. SASHCO INC, 96-1532
DCT SD/OH-92-CV-407

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. The disposition will appear in tables published periodically.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

96-1532

DAP PRODUCTS, INC.,

Plaintiff-Appellee,

v.

SASHCO, INC.,

Defendant-Appellant.

JUDGMENT

ON APPEAL from the UNITED STATES DISTRICT COURT, SOUTHERN DISTRICT OF OHIO

In CASE NO(S). C-3-92-407

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

Per Curiam: (MAYER, RADER, and BRYSON, Circuit Judges):

AFFIRMED. SEE Fed. Cir. R. 36.

ENTERED BY ORDER
OF THE COURT

Dated: April 14, 1997 s/_____
Jan Horbaly, Clerk

APPENDIX C

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1532

DAP PRODUCTS, INC.,

Plaintiff-Appellee,

v.

SASHCO, INC.,

Defendant-Appellant.

ORDER

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

ORDER

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and a response thereto having been invited by the court and filed by the APPELLEE, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc and response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same here is, **DENIED** and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, **DECLINED.**

The mandate of the court will issue on June 18, 1997.

FOR THE COURT,
JAN HORBALY, CLERK

Dated: June 11, 1997

By: s/_____
Alex Van Veen
Staff Law Clerk

cc: TIMOTHY J. MARTIN
PAUL G. HALLINAN

DAP PRODUCTS V. SASHCO INC, 96-1532
(DCT - 92-CV-407)